

### **III. REMARKS/ARGUMENTS**

The Office Action dated September 19, 2005, has been received and carefully considered. Claims 1-20 are pending in the application. Independent claims 1 and 10 have been amended. No new matter is added by this amendment. Applicants believe that the application is now in condition for allowance and notice thereof is respectfully requested.

#### **Interview**

Applicant and Applicant's representative appreciate the time the Examiner took to meet and discuss this case during the interview of February 13, 2006. Applicant demonstrated the number of disadvantages of existing devices used during a tonsillectomy and explained the advantages of his device using a prototype that he has fashioned. Applicant also explained how he perceived the Wojchiechowiz thermal insulating sleeve inside of the suction tube would have disadvantages and impede proper cauterizing. Applicant explained why it would not be obvious to modify Morrison in view of Wojchiechowiz. The Examiner indicated that such reasons could be set forth in a response and would be considered. In addition, the Examiner agreed that an amendment stating that the insulation termination plane and the cautery surface plane being substantially parallel would distinguish over Morrison and Wojchiechowiz, but that a further search would be required.

#### **Pending Rejections**

Claims 1-20 stand rejected under section 112, second paragraph due to alleged antecedent basis problems. Claims 1 and 10 have been amended to correct the identified deficiency and therefore, this rejection is now deemed to be moot.

Claims 1, 2, 6-10, 14-17, 19 and 20 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,730,742 to Wojchiechowiz (“Wojchiechowicz”).

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being allegedly unpatentable over Wojchiechowiz in view of U.S. Patent No. 3,828,780 to Morrison, Jr. (“Morrison”).

Independent claims 1 and 10 have been amended, in different manners, each of which are believed to overcome the rejections based on Wojchiechowiz and Wojchiechowiz in view of Morrison as proposed. Explanations are provided below.

**Claims 1-9 have been amended to overcome these rejections**

Claim 1 has been amended to recite features of the tip assembly that are not disclosed in Wojchiechowiz. Specifically, claim 1 now recites that the tip assembly “comprising a substantially co-planar, enclosed cautery surface with a beveled leading edge sharpened for dissecting tissue, the cautery surface being substantially co-planar to enable the cautery surface to contact tissue through the substantially co-planar surface and having an opening formed therein that communicates with the suction channel in the insulated tubing assembly without any intervening structure that limits the cautery surface from contacting the tissue in a substantially co-planar manner and the cautery surface being operably connected to an electrical source.” These features are clearly depicted in Applicants’ drawings and described in the specification.

Wojchiechowiz clearly fails to disclose this feature and therefore, the rejection of claims 1, 2 and 6-9 under section 102 should be withdrawn. In Figs. 7A-7C, the thermal insulating tube clearly is depicted as being disposed in an opening in the cautery surface which would “limit[s] the cautery surface from contacting the tissue in a substantially co-planar manner.” In Figs. 8A-8B, the structure fails to provide a substantially co-planar cautery surface that “enable[s] the

cautery surface to contact tissue through the substantially co-planar surface.” The nib 310 would prevent the surface from making substantially co-planar contact with a tissue surface.

Moreover, Claims 1-9 are patentable over the proposed rejection based on a proposed combination of Morrison in view of Wojchiechowiz. First, Morrison also clearly fails to disclose the now-recited elements of claim 1 because it fails to disclose “a cautery surface with a beveled leading edge sharpened for dissecting tissue.” The Office Action asserts that it would have been obvious to modify Morrison in view of Wojchiechowiz to provide such a beveled leading edge to facilitate tissue dissection. While Wojchiechowiz indicates that “the leading edge faces 106 and 206 of Figs. 7A and 7B act as a knife edge to cut through materials,” the primary teaching of Wojchiechowiz is the inclusion of a thermal insulation on the interior of the channel formed by the cautery surface. One of ordinary skill in the art would not have been motivated to modify Morrison to provide a beveled leading edge to facilitate tissue dissection with an opening formed in the cautery surface “without any intervening structure that limits the cautery surface from contacting the tissue in a substantially co-planar manner.” A reference is good for everything that it teaches. Here, the Wojchiechowiz reference only discloses a beveled leading edge that does not have a substantially co-planar cautery surface (Figs. 8A-8B) or one that has a substantially co-planar cautery surface with an opening that has an intervening structure that limits the cautery surface from contacting the tissue in a substantially co-planar manner (Figs. 7A-7C having the thermal insulating tube). Thus, even if one of ordinary skill in the art may have been motivated by Wojchiechowiz to modify Morrison, such a person would have modified Wojchiechowiz to provide a tip as disclosed in either Figs. 7A-7C or one as disclosed in Figs. 8A-8B.

Accordingly, the amendment to claim 1 renders claims 1-9 patentable over the rejections presented.

**Claims 10-20 have been amended to overcome these rejections**

As discussed during the interview with the Examiner, claim 10 has been amended to recite a feature that the Examiner acknowledged was not disclosed by Morrison or Wojchiechowiz. Specifically, claim 10 has been amended to recite that the “cautery surface comprising a cauterizing plane,” “the insulating layer terminating at a substantially co-planar insulation termination plane” and the “cauterizing plane and the insulation termination plane are substantially parallel.” Neither Morrison or Wojchiechowiz disclose this feature, as the Examiner acknowledged. Therefore, claims 10-20 should be allowable over the rejections of record.

Accordingly, Applicants respectfully submit that in view of the above amendment and remarks, all of the pending claims are now allowable over the cited references and request that the instant rejection of claims 1-20 be withdrawn.

**V. Conclusion**

For the reasons set forth above, it is respectfully submitted that all outstanding rejections have been overcome or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record. Any amendments are supported by the specification. Applicants accordingly submit that these claims are in a condition for allowance. Reconsideration and allowance of all claims is respectfully requested.

If the Examiner believes that a telephone conference or interview would advance prosecution of this application in any manner, the undersigned stands ready to conduct such a conference at the convenience of the Examiner.

If there are any fees due which are not enclosed herewith, including any fees required for extension of time under 37 C.F.R. §1.136, please charge such fees to our Deposit Account No. 50-0206.

Respectfully submitted,

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